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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,411	07/19/2001	Sharon Drew Morgen	23091-P001US	7298
34082	7590	07/20/2005	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			JARRETT, SCOTT L	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 07/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,411

Applicant(s)

MORGEN, SHARON DREW

Examiner

Scott L. Jarrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the submitted drawings are informal and/or illegible. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method for making criteria-based decisions on a website.

The attempt to incorporate subject matter into this application by reference to Selling with Integrity by Sharon Drew Morgen (1997) on specification page 6 lines 19-21 is ineffective because a legible copy of the non-patent literature publication or that portion which caused it to be listed was not provided and listed in an appropriate information disclosure sheet.

Examiner respectfully requests a legible copy of the non-patent literature publication or that portion which caused it to be incorporated by reference.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

The public use or sale of the invention of facilitating buyers through a decision making process utilizing questions and answers also referred to by the applicant as Buying Facilitation® is evidenced by at least the following:

- Parr, Jan, It's the buyer stupid (1996);
- Morgen, Sharon, Selling with Integrity (1997);
- Morgen, Sharon, Serving need not greed: how business can partner with customers (1998); and
- Morgen, Sharon, "Stupid" Selling: Let the Client Lead the Way (1998).

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: the use or public sale of criteria based selling as discussed in the applicant's book Selling with Integrity (1997), NewSalesParadigm.com web site or other materials (seminars,

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brochures, training manuals, press releases, etc.) which discuss or are related to facilitating buyers through a decision making process utilizing questions and answers (question/response methodology).

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgen, Sharon, Selling with Integrity (1997).

Regarding Claims 1-4 Morgen teaches a method for making criteria based decisions utilizing a question/response methodology (buying facilitation method) comprising:

- presenting one or more set of questions to a visitor (user, potential buyer, etc.; Pages 6-8, 23) wherein the one or more sets of questions assist the visitor in determining (pages 36-39):
 - what is missing with respect to a problem the visitor is seeking to resolve;
 - why the visitor is unable to adequately solve the problem with the resources they already have;
 - whether an identified solution to the problem is acceptable to the visitor when compared to the visitor's criteria;

- visitor's criteria include cultural norms held by the visitor (Page 7, Step 6);
- the questions are interrelated/branching questions wherein subsequent questions asked depend on the previous set of questions asked/answered (Pages 6-8);
- presenting (providing) additional information on the identified solution (Page 39, Paragraph 6).

Morgen does not expressly teach that the facilitating buyers (visitors) through a decision-making process utilizing a series of adaptive/dynamic questions and answers is conducted over the Internet (i.e. while a user is browsing a web site) as claimed.

Official notice is taken that conducting sales over the Internet is old and well known and that the Internet has been utilized to automate a plurality of manual activities including sales.

Furthermore, it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

It would have been obvious to one skilled in the art at the time of the invention that the method of making criteria based decisions as taught by Morgen would have benefited from utilizing any of a plurality of Internet technologies to automate the buyer

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facilitation process; the resultant system providing an effective sales process by enabling visitors (buyers) to discover/solve their own problems (Page 6, Final Paragraph).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Suzuki et al., U.S. Patent No. 5,890,139, teach method and system enabling web site visitors (customers) make a criteria based decision when browsing a web site utilizing a question and response methodology.
- Fagg et al., U.S. Patent No. 5,978,784, teach method and system for enabling users to make criteria based decisions utilizing a question and response methodology.
- Tavor et al., U.S. Patent No. 6,070,149, teach an online system and method for facilitating the buying process of a visitor browsing a web site utilizing questions and corresponding answers to guide/consult the user in making a purchasing decision.
- Rofrano, John Joseph, U.S. Patent No. 6,035,283, teaches an Internet-based system and method for enabling web site visitors to make criteria based decisions based on the visitor's needs while browsing (accessing, navigating, etc.) the web site that utilizes a question decision tree consisting of a series of related questions and answers to facilitate the buying process.
- Ruppelt et al., U.S. Patent No. 6,795,810, teach an online system and method for assisting a user in reaching a buying/purchasing decision.
- Freese, Thomas A., Secrets of Question Based Selling, teaches a method for facilitating the buying process utilizing a series of questions.
- NewSalesParadigm.com (June 2000) web pages, teaches the public use and commercial availability of the Buying Facilitation method and system that "supports

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buyers by using an artificial intelligence questioning method to support their own answers."

- NewSalesParadigm.com (January 2001) web pages, teaches the public use (books, training materials, seminars, etc.) and commercial availability of the Buying Facilitation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Jarrett whose telephone number is (571) 272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SJ

7/17/2005



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